

First Amendment
U.S. Patent Application Serial No. 10/039,565
Office Action Dated: May 23, 2005
Inventor: Andrew Mark Stringer
Attorney Docket No. 41759-57619

REMARKS

This Amendment is filed in response to the Office Action dated May 23, 2005 along with a one (1) month extension of time.

Objection Under 37 C.F.R. Section 1.75(c):

Claim 5 was objected to for failing to limit the subject matter of the previous claim. It is respectfully believed that this objection is erroneous. Claim 5 provides the new feature that the **electronic data request sent to the server** has a data field representing a commercial value, as opposed to the **electronic data** of Claim 1 sent by **the server** having a data field representing a commercial value. This is clearly an additional delineating limitation of Claim 1 found in Claim 5 where **both** the electronic data request and the electronic data each separately contain a data field representing a commercial value. Therefore, it is respectfully believed that Claim 5 provides an additional limitation that is not found in Claim 1 and this objection is overcome.

Rejections Under 35 U.S.C. Section 103(a):

Claim 1 was rejected under 35 U.S.C. Section 103 as being unpatentable over Naik. Although the listed rejection refers to Saari et al. (U.S. Patent No. 6,338,046), a

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telephone conversation with Examiner Neutrauter on September 16, 2005 indicated that Naik was, in fact, the correct prior art reference.

Naik is a general purpose reference document on standards and protocols dating from around 1998. Naik makes a number of references to the IETF's (Internet Engineering Task Force) RFC (Request For Comments) Documents (Page 37, First Paragraph, Page 40, First Paragraph) when further or complete details are required. In fact, Naik is simply an explanation of many of the protocols implemented by the RFC documents.

The rejection of Claim 1 is based on Naik and the Examiner states that Naik suggests that if any data may be used in a field then erroneously jumps to the conclusion that someone with ordinary skill in the art would use commercial values in the data fields without the slightest hint or suggestion from any prior art reference for taking this action.

It is respectfully submitted that it is not obvious to use commercial values within a data field of a packet header. In fact, the prior art teaches away from using data fields within packets to record commercial values.

However, in order to further differentiate over the prior art Claim 1 has been amended to introduce features from Claim 8 as originally filed. In particular Claim 1 now recites that:

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- (a) electronic data is sent **in the form of packets;**
- (b) **the operation of the server is governed by a server protocol** which causes the electronic data to include the commercial value data field; and
- (c), **each router has a router protocol which causes the router to forward a data packet in accordance with a routing table and to update the value contained in the data field to reflect a corresponding added commercial value.**

Naik is merely a general background article involving internet and transport protocols. By adhering to the protocols, equipment, despite being manufactured by various parties, can still enable reliable data transfer in a variety of environments. The protocols do not necessarily limit the use of other fields but insist on the presence of certain fields.

In this manner, packets may be reliably transferred by any piece of equipment, but the protocols also allow for custom manipulation and addition of data and data fields for custom systems, as required.

Many of the other cited documents (including U.S. Patent No. 6,490,287 and U.S. Patent No. 6,515,989) refer to charging systems for packet networks. All of these documents, despite the Internet protocols referred to in Naik being available for a considerable time previous to these documents, teach away from using a data field within a packet to hold a commercial value. The charging systems utilize such

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methods as counting data packets and measuring the associated lengths of data packets. It was explicitly held in In re Sang Sung Lee, 61 U.S.P.Q.2d 1430 (C.A.F.C. 2002) that the "Board of Patent Appeals and Interferences improperly relied upon "common knowledge and common sense" of person of ordinary skill in art to find invention of patent application obvious over combination of two prior art references, **since a factual question of motivation to select and combine references is material to patentability, and could not be resolved on subjective belief and unknown authority**, since deferential review of agency decisions under Administrative Procedure Act reinforces obligation of board to develop evidentiary basis for its findings, since board's rejection of need for any specific hint or suggestion in particular reference to support combination constituted omission of relevant factor required by precedent, and thus was both legal error and arbitrary agency action, since board's findings must extend to all material facts and be documented on record, and since "common knowledge and common sense" are not specialized knowledge and expertise of agency contemplated by APA, and may not be substituted for evidence, although they may be applied to analysis of evidence." Also, In re Sang Sung Lee recites: "Rejection of patent application for obviousness under 35 U.S.C. Section 103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or

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suggestion to select and combine references relied on as evidence of obviousness;
factual inquiry whether to combine references must be thorough and searching,
based on objective evidence of record, and Board of Patent Appeals and
Interferences must explain reasons why one of ordinary skill in art would have been
motivated to select references and to combine them to render claimed invention
obvious." In this case, there is no objective evidence of record that would lead an individual of ordinary skill in the art to place a commercial value in a data field.

The difference between the prior art and Claim 1 is that Claim 1 is directed to "a method of electronic payment" wherein the commercial value is contained within a data field within the electronic data. The prior art describes the internet and transport protocols and the various associated data fields and various charging strategies for packet based network traffic. At no point does the prior art teach the use of a data field to hold a commercial value and so contains no hint to features (a), (b) and (c) defined above. In fact, the prior art which relates charging for network traffic teaches away from using packet headers altogether. "In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." In re Linter, 458 F.2d 1013, 1016, 173 USPQ

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560, 562 (CCPA 1972). There is nothing disclosed regarding a data field to hold a commercial value and not the slightest hint or suggestion as to why this claimed feature should be created.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

Although Naik suggests that a data field may be used for containing any data, it does not disclose the use of a data field for measuring the commercial value of the data. Moreover, it does not disclose the feature, now introduced into Claim 1, that as the data packet is transferred across the computer network by a router, the router updates the commercial value data field to reflect the value added by the forwarding of the data by the router. This key feature enables a router to record the value added by the

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component step in the overall process of supplying information to the end user. In other words, at each step in the process to supply information, value is added over and above the intrinsic value of the information. Hence, the cost of providing the information and the cost of transporting the information can both be enumerated and accrued in the same commercial value data field.

The ordinary skill at the time of invention, which is prior to the foreign priority date of June 22, 1999, is considerably different to the current ordinary skill, as knowledge of the internet and network protocols is far more widespread. Prior to June 22, 1999, the ordinary skill should be taken to be a person with knowledge of internet protocols along with a knowledge of charging for network traffic as described in the cited prior art. The man or woman with ordinary skill in the art would not be able to combine the two since packet data fields are not used in other charging-related prior art. It would not be obvious to use a commercial value data field for this purpose because of the weight of prior art teaching away from this solution.

The Applicant's patent application refers at numerous points to packets and specifically to various fields within the packet used for other purposes (Stringer, U.S. Patent Application No. 2002/0083186, Page 10, Lines 16-20. Paragraph [0037], Page 9, Lines 15-18, Paragraph [0035], Page 18, Lines 28-21, Paragraph [0070]). In particular, the Patent Application mentions that fields have "been proposed by other

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bodies as part of existing technical specifications" (Stringer, U.S. Patent Application No. 2002/0083186, Page 9, Lines 16-18, Paragraph [0035]). The patent application acknowledges other protocols and their suggested use of particular fields to store particular data. **However, since there is no specific prior art disclosing the use of a commercial value data field as disclosed by the present Invention, then the invention was clearly non-obvious to practitioners in the art when the invention was conceived. It is well established in U.S. Patent Law as well as the Manual for Patent Examining Procedure (M.P.E.P.) Section 2143.03 that to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). In this case, the limitation regarding utilizing a commercial value is not taught or suggested by the prior art.**

It should be noted that Claim 1 now includes the limitations of Claim 8. The Examiner indicated at page 6 of the Office Action that, in his view, Claim 8 contains substantially the same limitations as Claims 1 and 3 combined. This is respectfully denied. Claim 3 does not refer to router and server protocols. Moreover, in his discussion of Claim 3 at Page 5 of the Office Action the Examiner equates a TTL field

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with the commercial value data field of the invention. The TTL field is a simple indicator which is reduced by one at each network node. As such, it serves specifically to influence the future processing of the packet at subsequent network nodes and, in particular, it contains no information related to the history or content of the packet.

Furthermore, the TTL functionality makes no reference to any routing criteria, as derived from the routing table, nor to any commercial considerations and it does not apply any kind of algorithm in order to determine how to update the value. In contrast, such protocol elements all exist within the scope of the system and method of the present invention.

The Applicant has considered the other prior art cited by the Examiner and considered pertinent by the Examiner. The Applicant respectfully submits that none of the cited prior art discloses or hints at a method and system of electronic payment including features (a), (b) and (c) defined above. It is also pointed out that the corresponding European Patent Application has proceeded to grant as European Patent No. 1188154 with claims of the same scope as the presently amended claims.

A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a

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prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). Therefore, it is respectfully believed that Claim 1 overcomes the rejection under 35 U.S.C. Section 103 and is patentable over Naik and is in condition for allowance.

Claims 2-6 and Claims 8-15 are also rejected under 35 U.S.C. Section 103 over Naik. Claims 2, 10, and 11 are now cancelled and it is respectfully believed that this rejection with regard to these Claims is rendered moot. Claims 3-6 and Claims 12-15 are now amended to depend from Claim 1. If an independent claim is nonobvious under 35 U.S.C. Section 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Therefore, Claims 3-6 and Claims 12-15 overcome the rejection under 35 U.S.C. Section 103 and are in condition for allowance.

Claim 8, like Claim 1, was rejected under 35 U.S.C. Section 103 as being unpatentable over Naik.

Claim 8 is an independent claim directed to a system of electronic payment, and includes features corresponding to the method of electronic payment of Claim 1. In particular it includes the following features which correspond to features (a), (b) and (c) of Claim 1 defined above:

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- (d) at least one server for providing electronic data in the form of data packets;
- (e) [the server] having its operation governed by a server protocol which causes each data packet sent by the server to have associated with it a data field representing the value of the data contained in the packet; and
- (f) at least one router having its operation governed by a router protocol which causes each router to forward a data packet in accordance with the routing table and to update the value contained in the data field within the packet to reflect a corresponding added commercial value.

Therefore, for the reasons provided above with respect to Claim 1, the subject matter of Claim 8 is both novel and non-obvious. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). In this situation, there is absolutely no suggestion regarding the utilization of a commercial value in a data field.

Therefore, it is respectfully believed that Claim 8 overcomes the rejection under 35 U.S.C. Section 103 and is patentable over Naik and is in condition for allowance.

Claim 9 depends from Claim 8 and contains each and every limitation thereof. If an independent claim is nonobvious under 35 U.S.C. Section 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596

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(Fed. Cir. 1988). Therefore, Claim 9 overcomes the rejection under 35 U.S.C. Section 103 and is in condition for allowance. Claim 9 depends from Claim 1 and contains each and every limitation thereof.

Claim 7 was rejected under 35 U.S.C. Section 103 as being unpatentable over Naik and further in view of Saari et al. (U.S. Patent No. 6,338,046). Since Claim 7 depends from Claim 1, as amended, and contains each and every limitation thereof. If an independent claim is nonobvious under 35 U.S.C. Section 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Also, it is respectfully believed to be axiomatic, that a feature not disclosed in either of two cited references cannot come into being by their combination. In this case, the use of a data field for measuring the commercial value of the data is not disclosed in either Naik or Saari et al.

Therefore, it is respectfully believed that Claim 7 overcomes the rejection under 35 U.S.C. Section 103 and is patentable over Naik in view of Saari et al. and is in condition for allowance.

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Therefore, Applicant respectfully requests favorable consideration and allowance of this patent application, as currently amended. If a telephone interview would facilitate this matter, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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Dated: September 23, 2005